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Application Number	09/782,539
Filing Date	February 13, 2001
First Named Inventor	Danielle C. Brotto, et al.
Group Art Unit	2838
Examiner Name	P. Tibbits

Total Number of Pages in This Submission

Attorney Docket Number

TN-1379A

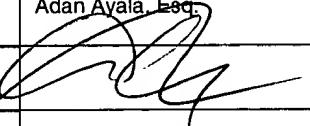
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Name (Print/Type)	Adan Ayala, Esq.	Registration No. Attorney/Agent	38,373	Telephone	410-716-2368	
Signature					Date	November 8, 2002

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Rec'd 11/18/02

UTILITY PATENT



#14
Docket No.
11-14-02
Appeal Brief

B&D No. TN-1379A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: **Daniele C. BROTTO et al.**

Serial No.: **09/782,539**

Examiner: **P. Tibbits**

Filed: **February 13, 2001**

Group Art Unit: **2838**

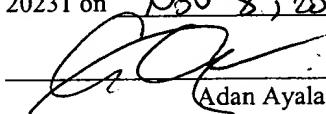
For: **POWER TOOL WITH MEANS FOR OBTAINING
PRODUCT USE INFORMATION (as amended)**

Assistant Commissioner for Patents

Washington, DC 20231

APPEAL BRIEF

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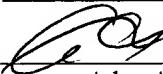
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APPEAL BRIEF

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Adan Ayala

Dear Sir:

I. INTRODUCTION

In response to the Final Office Action mailed July 3, 2002, a Notice of Appeal was mailed on September 27, 2002, for the above-identified application. The present appeal brief is being timely filed in triplicate, as required under 37 CFR § 1.192.

II. REAL PARTY IN INTEREST

The real party in interest in the present case is Black & Decker Inc. An assignment transferring all rights to the present application and resulting patents was filed in the parent application. The assignment was recorded on April 15, 1999, and can be found at Reel 9911, Frame 0256.

III. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences related to the present case are currently pending.

IV. STATUS OF CLAIMS

Claims 25-28 and 30-32 are currently pending in the present application. Claims 25-32 are rejected and presently appealed.

V. STATUS OF AMENDMENTS

No amendment has been filed in response to the Final Office Action.

VI. SUMMARY OF INVENTION

Pursuant to 37 CFR § 1.192 and MPEP § 1206, Applicant/appellant hereby provides a concise explanation of the inventions defined in the claims involved in the present appeal. This explanation refer to the specification by page and line number and to the drawings, as required by the CFR and the MPEP rules. However, the following explanation only refers to the embodiments disclosed in the specification and does not discuss alternative mechanisms that would be covered by

the claims. Accordingly, the following explanation should not be used to limit the scope of the claims.

Independent Claim 25 calls for a power tool 40 comprising a memory 44 for storing use profile information about the tool 40. Spec., p. 8, lns. 3-10. Use profile information is information stored in the memory 44 concerning the manner in which the tool 40 is used. This information can include tool temperature, length of use, number of times the tools has been turned on, etc. Spec., p. 8, lns. 12-14. This stored information is downloadable into a reader apparatus. Spec., p. 8, lns. 15-16.

Claim 26 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 26 further defines that the stored information comprises at least one of the group consisting of tool temperature, length of use, and number of times tool has been turned on. Spec., p. 8, lns. 12-14.

Claim 27 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 27 further defines that the stored information is downloadable. Spec., p. 8, lns. 15-16.

Claim 28 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 28 further defines that the stored information is downloadable into a computer. Spec., p. 8, lns. 15-16.

Claim 30 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 30 further defines that the stored information comprises length of use. Spec., p. 8, lns. 12-14.

Claim 31 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 31 further defines that the memory 44 is non-volatile. Spec., p. 8, lns. 10-11.

Claim 32 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 32 further defines that the memory 44 comprises an E²PROM memory. Spec., p. 8, lns. 10-11.

VII. ISSUES

- A. Whether Claims 25-28 and 30-32 are unpatentable under 35 USC § 103(a) over US Patent No. 5,903,462 (“Wagner”).
- B. Whether Claims 25-28 and 30-32 are unpatentable under 35 USC § 103(a) over US Patent No. 4,636,961 (“Bauer”).

VIII. GROUPING OF CLAIMS

- A. As to the rejection based on Wagner, Claims 25, 27-28 and 31-32 stand together as Group I; and Claims 26 and 30 stand together as Group II.
- B. As to the rejection based on Bauer, Claims 25 and 31-32 stand together as Group I; Claims 26 and 30 stand together as Group II; and Claims 27-28 stand together as Group III.

IX. ARGUMENT**A. Claims 25-28 and 30-32 are Patentable under 35 USC § 103(a) over Wagner.**

The Board should reverse the Examiner’s improper final rejection of Claims 25-28 and 30-32 under 35 USC § 103(a) based on US Patent No. 5,903,462 (“Wagner”). In particular, Wagner

does not show all the claimed elements the missing elements. Therefore, the Examiner's rejection was improper and should be reversed.

As mentioned above, Claims 25-28 and 30-32 are grouped in three separate groups. First, Claims 25, 27-28 and 31-32 stand together as Group I. Second, Claims 26 and 30 stand together as Group II, as they are separately patentable over the other claims. This is because both claims call for the stored information to include length of use.

1. Claims 25, 27-28 and 31-32 are Patentable over Wagner.

The Board should reverse the Examiner's final rejection of Claims 25, 27-28 and 31-32 for not including having all the claimed elements.

Claim 25 calls for a power tool comprising a memory for storing use profile information about the tool, wherein the stored information is downloadable into a reader apparatus. Claims 27-28 and 31-32 are ultimately dependent upon Claim 25 and thus include the elements of Claim 25.

Admittedly, Wagner discloses a power tool with a memory for storing performance records, which include torque, angle and time information on fasteners being operated thereon, as well as "when the tool powered up, or when a temperature fault occurred." However, Wagner does not disclose downloading such performance records into a reader apparatus for later analysis. Instead, Wagner discloses directly connecting the power tool to a computer for analyzing the stored information.

By contradistinction, Claim 25 requires that the "stored information [be] downloadable into a reader apparatus." Such feature is critical as it allows a person to obtain the store information at the construction jobsite without bringing fragile computers to hook up to the power tool.

In addition, there is no suggestion to modify Wagner's direct connection to a computer with a separate reader apparatus because such modification would change the principle of operation. According to the CCPA, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In Wagner, the stored information is directly obtained and analyzed by the computer connected to the power tool, rendering the need for an additional reader apparatus superfluous. Since the reader apparatus is superfluous, adding a reader apparatus to Wagner would change the principle of obtaining and analyzing information. Accordingly, no suggestion exists to modify Wagner as proposed by the Examiner. Therefore, Wagner cannot render Claims 25 and 31-32 unpatentable.

The Examiner argues that the computer used in Wagner is the claimed "reader apparatus." In particular, "the remote computer could be considered to be a reader since it could analyze and optimize a process by suing information stored in memory for feedback." This reading, however, would violate the rule that the claims must be interpreted so as to be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).¹

¹ The Examiner's failure to follow, or even acknowledge, such rule is not surprising, as the Examiner apparently believes that claims are to be "interpreted in light of the specification." This contradicts the MPEP warning that "[w]hile the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination." MPEP § 2111.01, at 2100-47 (8th ed., Aug. 2001).

In the present case, a person skilled in the art will recognize that a “reader apparatus” is different than a computer. Why? Because the specification states that the information to be downloaded from charger 20 “can be accomplished by connecting the charger 20 to a reader 50 and/or a computer 53.” (Spec. p. 8, lns. 15-16). In other words, reader 50 is different from computer 53. Reader 50 is further distinguished in the specification since it “receives the information, stores it into memory 52” and later “sends it to computer 53 for analysis.” (Spec., p. 9, lns. 3-4). Again, the specification distinguishes reader 50 from computer 53. Such distinction is shown in FIG. 4, and consistently found in the specification, even in other disclosed embodiments. Accordingly, a persons skilled in the art would recognize that the claimed “reader apparatus” is different than a computer. Therefore, the Examiner cannot interpret “reader apparatus” to be the computer.

Nonetheless, the Examiner manufactures a quote in the specification to support her point. In particular, the Examiner notes that “[t]he specification on page 8 describes the reader as conducting ‘a hand-shaking routine...to induce...transmitting the information stored in (the power tool’s memory to the computer.’” This quote does not exist in the specification. The specification instead reads “[r]eader 50 and controller 42 may conduct a hand-shaking routine to induce controller 42 into transmitting the information stored in [the power tool’s] memory 44.” (Spec., p. 8, lns. 18-19). Accordingly, the specification does not support the Examiner’s allegations.

Due to the Examiner’s flawed interpretation of the claimed “reader apparatus” element, the rejection of Claims 25 and 31-32 under Wagner is improper and should be reversed by the Board.

2. Claims 26 and 30 are Patentable over Wagner.

The Board should reverse the Examiner's final rejection of Claims 26 and 30 for not including having all the claimed elements.

Claims 26 and 30 are ultimately dependent upon Claim 25, and thus the arguments of Section IX(A)(1) above apply. In addition, Claim 30 requires that the stored information comprise length of use, i.e., how long the power tool has been used. Further, Claim 26 calls for other values that may be stored, including tool temperature and number of times the power tool has been turned on.

As admitted above, Wagner discloses a power tool with a memory for storing performance records, which include torque, angle and time information on fasteners being operated thereon, as well as "when the tool powered up, or when a temperature fault occurred." Wagner however does not disclose storing in this memory use profile information as tool temperature, length of use and/or the number of times the tool has been turned on. Indeed, the Examiner admits that "Wagner does not disclose 'use profile information' specifically."

By contradistinction, Claim 26 calls for "the stored information [to comprise] at least one of the group consisting of tool temperature, length of use, and number of times tool has been turned on." Claim 30 calls for "the stored information [to comprise] length of use." This allows a person to obtain this information at a later time and to analyze it. (See, e.g., Specification, page 8, line 15 to page 9, line 5.) Obtaining this use information provides useful insights as to how a user uses and interacts with a power tool, which in turn can be used to design a better product. Spec., p. 1, lns. 14-16. Because Wagner does not disclose or suggest a memory for storing use information, or the specific information to be stored, as called for in Claims 26 and 30, Wagner cannot render Claims 26 and 30 unpatentable.

Rather than allowing the claims, the Examiner argued that “it would have been obvious to one of ordinary skill in the art that it is an inherent function of Bauer’s apparatus to provide use profile information since it discloses information relevant to the operation of the tool, and MPEP 2100 states that the disclosure of a limitation may be expressed, implicit or inherent.”

Admittedly, a rejection can be made under 35 USC §103(a) when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic. However, the fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherency of that characteristic. *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981).

Indeed, the Federal Circuit requires that:

[t]o establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

In re Robertson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Furthermore, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). In the present case, the Examiner has not provided any proof that the Wagner device would necessarily store the use profile information specifically called for in Claims 26 and 30.

This is not surprising, as the Examiner has admitted that Wagner does not disclose storing any type of use profile information. Because the Examiner has failed to show that storing the use profile information called for in Claims 26 and 30 is necessarily present in the Wagner device, and

thus inherent thereto, Wagner cannot render Claims 26 and 30 unpatentable. Accordingly, the Board should reverse the Examiner's rejection of Claims 26 and 30.

B. Claims 25-28 and 30-32 are Patentable under 35 USC § 103(a) over Bauer.

The Board should reverse the Examiner's improper final rejection of Claims 25-28 and 30-32 under 35 USC § 103(a) based on US Patent No. 4,636,961 ("Bauer"). In particular, Bauer does not show all the claimed elements, and no suggestion exists for modifying Bauer with the missing elements. Therefore, the Examiner's rejection was improper and should be reversed.

As mentioned above, Claims 25-28 and 30-32 are grouped in three separate groups. First, Claims 25 and 31-32 stand together as Group I. Second, Claims 26 and 30 stand together as Group II, as they are separately patentable over the other claims. This is because both claims call for the stored information to include length of use.

Further, Claims 27-28 stand together as Group III, because they both call for the stored information to be downloadable, which is not explicitly claimed in the other claims.

1. Claims 25 and 31-32 are Patentable over Bauer.

The Board should reverse the Examiner's final rejection of Claims 25 and 31-32 for not including having all the claimed elements.

Claim 25 calls for a power tool comprising a memory for storing use profile information about the tool, wherein the stored information is downloadable into a reader apparatus. Claims 31-32 are ultimately dependent upon Claim 25 and thus include the elements of Claim 25.

Admittedly, Bauer discloses a power tool with a memory 15. As admitted by the Examiner, Bauer does not disclose a memory for storing use profile information about the tool. Instead, Bauer

discloses a power tool with a read-only memory (ROM), which is programmed with control information prior to sale. Bauer, col. 3, lns. 35-37. The Examiner has admitted that the ROM has values that “are fed to the control device of the motor of the tool... As a result the optimum rotary speed of the electric motor of the tool is adjusted.” In other words, the ROM contains control information for controlling the rotary speed value (Bauer, col. 4, lns. 37-40), but not use profile information concerning the manner in which the user is using the power tool.²

By contradistinction, Claim 25 calls for “a memory for storing use profile information about the tool.” This information would include, for example, the tool temperature, length of use, number of times the tool has been turned on, etc. (See, e.g., Specification, page 8, lines 13-14.) This allows a person to obtain this information at a later time and to analyze it. (See, e.g., Specification, page 8, line 15 to page 9, line 5.) Therefore, Bauer does not disclose or suggest all the claimed elements.

While admitting that Bauer does not disclose all the claimed elements, the Examiner argues that “it would have been obvious to one of ordinary skill in the art that it is an inherent function of Bauer’s apparatus to provide use profile information since it discloses information relevant to the operation of the tool, and MPEP 2100 states that the disclosure of a limitation may be expressed, implicit or inherent.” Admittedly, a rejection can be made under 35 USC §103(a) when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic. However, the fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherency of that characteristic. *Rijckaert*, 28 USPQ2d at 1957; *Oelrich*, 212 USPQ at 326.

² The Examiner notes that Bauer also discloses a programmable ROM (PROM) which “can be programmed by the user and easily reprogrammed.” Bauer, col. 4, lns. 42-44. However, the information that is stored in the PROM is still control information relating to the rotary speed, not information as to how the user is using the tool.

Indeed, the Federal Circuit requires that:

[t]o establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

Robertson, 49 USPQ2d at 1950-51.

Furthermore, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Levy*, 17 USPQ2d at 1464. In the present case, the Examiner has not provided any proof that the Bauer device would necessarily store “use profile information.”

This is not surprising, as the Examiner has admitted that Bauer does not disclose such element. In addition, there is no need for the Bauer device to store “use profile information” as the information therein is stored for controlling the device, rather than for delivering use data that can be analyzed at a later time. Because the Examiner has failed to show that storing “use profile information” is necessarily present in the Bauer device, and thus inherent thereto, Bauer cannot render Claims 25 and 31-32 unpatentable. Accordingly, the Board should reverse the Examiner’s rejection of Claims 25 and 31-32.

2. Claims 26 and 30 are Patentable over Bauer.

The Board should reverse the Examiner’s final rejection of Claims 26 and 30 for not including having all the claimed elements.

Claims 26 and 30 are ultimately dependent upon Claim 25, and thus the arguments of Section IX(B)(1) above apply. In addition, Claim 30 requires that the stored information comprise

length of use, i.e., how long the power tool has been used. Further, Claim 26 calls for other values that may be stored, including tool temperature and number of times the power tool has been turned on.

As admitted above, Bauer discloses a power tool with a ROM memory 15 that control information for controlling the rotary speed value. Bauer, col. 4, lns. 37-40. Bauer however does not disclose storing in this memory use profile information as tool temperature, length of use and/or the number of times the tool has been turned on.

By contradistinction, Claim 26 calls for “the stored information [to comprise] at least one of the group consisting of tool temperature, length of use, and number of times tool has been turned on.” Claim 30 calls for “the stored information [to comprise] length of use.” This allows a person to obtain this information at a later time and to analyze it. (See, e.g., Specification, page 8, line 15 to page 9, line 5.) Obtaining this use information provides useful insights as to how a user uses and interacts with a power tool, which in turn can be used to design a better product. Spec., p. 1, lns. 14-16. Because Bauer does not disclose or suggest a memory for storing use information, or the specific information to be stored, as called for in Claims 26 and 30, Bauer cannot render Claims 26 and 30 unpatentable.

In addition, there is no suggestion to modify Bauer’s preprogrammed memory storing control information with a storage memory for length of use and/or other use parameters as implied by the Examiner for several reasons. First, such modification would change the principle of operation. As discussed above, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In the present case, the ROM in Bauer is used for controlling the

motor speed. Since the Bauer memory does not store length of use information or other information as to how the user uses the tool, the principle of using a memory for controlling a parameter is changed.

Second, such modification would render the Bauer device unsatisfactory for its intended purpose. If the proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As admitted by the Examiner, the Bauer device has a memory with control information for controlling and optimizing the motor speed. If the Bauer memory is replaced with a memory for storing use profile information with length of use information, etc., then the memory will not have the necessary control information for controlling and optimizing the motor speed. Accordingly, such modification would render the Bauer device unsatisfactory for its intended purpose. For these reasons, no suggestion exists to modify Bauer as proposed by the Examiner. Therefore, Bauer cannot render Claims 26 and 30 unpatentable.

The Examiner has ignored this argument and alleged that, as to Claim 30, “the stored information comprising length of use type data, absent any criticality, is considered to be nothing more than a choice of engineering skill, because neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as an operator will be able to optimize the parameters of the tool.” Applicants/appellant submit that the present invention provides “results which are different in kind and not in degree from the results of the prior art” and that the type of stored information is critical. Since Bauer does not store information as to how the power tool is used, including the length of use, it cannot deliver this data to engineers that can use it for better product design. On the other

hand, the intent of the present invention is to store and deliver actual use data to engineers so they can design better tools. Because the results are radically different, the storing of length of use data is critical. Thus, Claims 26 and 30 are patentable over Bauer.

3. Claims 27-28 are Patentable over Bauer.

The Board should reverse the Examiner's final rejection of Claims 27-28 for not including having all the claimed elements.

Claims 27-28 are ultimately dependent upon Claim 25, and thus the arguments of Section IX(B)(1) above apply. In addition, Claim 27 requires that the stored information be downloadable. Claim 28 further requires that the stored information be downloadable into a computer.

As admitted above, Bauer discloses a power tool with a ROM memory 15 that control information for controlling the rotary speed value. Bauer, col. 4, lns. 37-40. Bauer however does not disclose downloading this information, especially into a computer.

By contradistinction, Claim 27 calls for "the stored information [to be] downloadable." Claim 28 further requires that "the stored information [be] downloadable into a computer." This allows a person to obtain this information at a later time and to analyze it. (See, e.g., Specification, page 8, line 15 to page 9, line 5.) Obtaining this use information provides useful insights as to how a user uses and interacts with a power tool, which in turn can be used to design a better product. Spec., p. 1, lns. 14-16.

Because Bauer does not disclose downloading information, the Examiner takes official notice with regard to Claim 28 that "the stored information is downloadable into a computer since it is well known in the art to use a computer to optimize a process by using information stored in memory for feedback." Even assuming for the sake of argument that the subject matter of the

official notice is correct, the Examiner has failed to meet the obviousness *prima facie* requirement that Bauer should be modified according to the subject matter of the official notice. This is because the Examiner has not pointed to any evidence that a motivation to modify Bauer in such manner exists.

Applicants/appellant submit there is no suggestion to modify Bauer's power tool with non-downloadable preprogrammed memory storing control information with a downloadable memory. "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the present case, Bauer does not suggest to a person of ordinary skill in the art to convert a non-downloadable power tool into a downloadable tool. Why? Because the information stored in Bauer's ROM is known by the engineers. Accordingly, an engineer would not learn anything new from that pre-programmed ROM that a code chart in his possession would not already show. Thus, a person of ordinary skill in the art would see no need or desire to download the information from that ROM. In other words, Bauer does not suggest the proposed modification to a person of ordinary skill in the art. Therefore, Bauer cannot render Claims 27-28 unpatentable.

X. APPENDIX

A copy of the claims involved in the appeal are hereby attached in an Appendix.

XI. CONCLUSION

Based on the foregoing, Applicants/appellant urge the Board to rule that Claims 25-28 and 30-32 are patentable over Bauer.

Respectfully submitted,



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Appendix attached

APPENDIX

25. A power tool comprising:

a memory for storing use profile information about the tool, wherein the stored information is downloadable into a reader apparatus.

26. The power tool of Claim 25, wherein the stored information comprises at least one of the group consisting of tool temperature, length of use, and number of times tool has been turned on.

27. The power tool of Claim 25, wherein the stored information is downloadable.

28. The power tool of Claim 25, wherein the stored information is downloadable into a computer.

30. The power tool of Claim 25, wherein the stored information comprises length of use.

31. The power tool of Claim 25, wherein the memory is non-volatile.

32. The power tool of Claim 25, wherein the memory comprises an E²PROM memory.